

REMARKS

Please reconsider the application in view of the above amendments and the following remarks. Applicant thanks the Examiner for carefully considering this application.

Inconsistent Response to Amendment

As an initial matter, Applicants respectfully note that the section titled "Response to Amendment," on page 1 of the non-final office action mailed on May 3, 2007, appears to be inconsistent with the referenced application. Namely, the aforementioned section comments on, e.g., claims 17-21, and on Applicants' arguments filed on 11/25/2005. However, the referenced application only contained claims 1-10 at the time of Applicants' previous response, which was mailed on February 2, 2007. Despite these inconsistencies, the remaining sections of the non-final office action mailed on May 3, 2007 only refer to claims 1-10, and, thus, the Applicants assume the Examiner erroneously inserted the aforementioned inconsistent paragraph under the "Response to Amendment" section. Accordingly, based on the above assumption, the Applicants respond to non-final office action mailed on May 3, 2007, as follows.

Disposition of Claims

Claims 1-10 were pending in this application. By way of this reply, new claims 11-14 have been added, and claims 9-10 have been cancelled without prejudice or disclaimer. Claims 1 and 8 are independent. The remaining claims depend, directly or indirectly, from claim 1 and 8.

Claim Amendments

Claims 1-8 have been amended to remove reference characters, and, as discussed previously, claims 9-10 have been cancelled without prejudice or disclaimer. New claims 11-14 have been added by this reply. Support for new claims 11-14 may be found, for example, in par. [0048] of the publication of U.S. Application Serial No. 10/531,821. No new matter has been added by any of the aforementioned amendments or the new claims.

Rejection under 35 U.S.C § 112

Claims 1-10 stand rejected under 35 U.S.C. § 112, paragraph 2, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. As discussed previously, claims 9-10 have been cancelled, thus rendering the rejection moot with respect to claims 9-10. To the extent that the rejection still applies to amended claims 1-8, the rejection is respectfully traversed.

The Examiner rejected claims 1-8 for not identifying the terms, "IMSI.sub.A", "ADM.sub.A", and "Ki.sub.A", which are all reference characters. Claims 1-8 have been amended to remove all reference characters including the terms, "IMSI.sub.A", "ADM.sub.A", and "Ki.sub.A". Thus, claims 1-8 are no longer indefinite. Accordingly, withdrawal of the rejection is respectfully requested.

Rejection(s) under 35 U.S.C § 102

Claims 1-2, 5, and 7-10 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication No. 20030092436 ("Boivin"). As discussed previously, claims

9-10 have been cancelled, thus rendering the rejection moot with respect to claims 9-10. To the extent that the rejection still applies to claims 1-2, 5, and 7-8, the rejection is respectfully traversed.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” MPEP § 2131. Applicants assert that Boivin fails to disclose all of the limitations of independent claim 1.

As discussed previously in the response filed on February 2, 2007 (“Previous Response”), one or more embodiments of the claimed invention is directed to replacing a first portable object (*e.g.*, an old SIM card) in a mobile phone with a second portable object (*e.g.*, a new SIM card), where the second portable object is activated with the first identification data via messaging (*e.g.*, SMS) with an application server. *See e.g.*, Previous Response, pp. 3-4.

Accordingly, independent claim 1 recites, *inter alia*, “a first sending step, in which the *communication device sends to an application server a message* including a second identification data identifying a second phone number assigned to the second portable object; [and] an inserting step, in which the *second portable object is inserted in the communication device...*” The aforementioned limitations explicitly require: (i) that the communication device communicate with the application server using a message (*e.g.*, SMS) including information that identifies second identification data correspond to a second portable object, *e.g.*, a new SIM card, during the first sending step; and (ii) insertion of the second portable object into the communication device during the inserting step.

Boivin's failure to disclose the first sending step

In contrast, Boivin is directed toward assigning a disposable telephone with a previously used mobile telephone number. Boivin merely discloses sending information from a disposable mobile device to a server via a telephone call, and is silent with respect to a communication device that communicates with the application server using a message (identifying the second portable object) as required by the claimed invention. *See* Boivin, par. [0025]. In fact, the portion of Boivin relied upon by the Examiner (*see e.g.*, Boivin, par. [0025]-[0030]) merely discloses keying in information while on a telephone call with the server. *See e.g.*, Boivin, par. [0026]. Moreover, Boivin explicitly discloses "...user input[s] information indicating whether the user desires to keep the same [previously used] telephone number, [or not]..." *See* Boivin, par. [0027]. Thus, even assuming *arguendo* that the Examiner equates a telephone call with sending a message, Boivin only indicates to the operator in the first step whether the old number or the new number should be retained. Thus, Boivin is silent with respect to a first sending step (*i.e.*, sending a message to the application server, including information identifying the second portable object) as required by independent claim 1.

Boivin's failure to disclose inserting a second portable object into the communication device

Further, Boivin is silent with respect to an inserting step, in which the *second portable object* (*e.g.*, new SIM card) is *inserted in the communication device* as required by the claimed invention.

Although the Examiner relies on a portion of Boivin (par. [0025]-[0030]) to show an inserting step, the aforementioned portion cited by the Examiner is actually directed to assigning a

disposable phone (regardless of the SIM card encapsulated inside) a previously used mobile number, and, is silent with respect to inserting any type of portable object. Moreover, Boivin is silent with respect to inserting or removing any type of object into the disposable phone. To that end, a disposable phone generally remains intact (*i.e.*, no alteration of components by end user), and, thus, there would be no way to insert a portable object into the communication device. Thus, Boivin is completely silent with respect to an inserting step as required by independent claim 1.

Because Boivin fails to disclose a first sending step and an inserting step, Boivin fails to disclose all the limitations of independent claim 1. Thus, independent claim 1 is patentable over Boivin. Independent claim 8 is believed to include at least the same patentable limitations as independent claim 1 and thus, is patentable over Boivin for at least the same reasons as independent claim 1. Further, dependant claims are patentable over Boivin for at least the same reasons as independent claim 1. Accordingly, withdrawal of this rejection is respectfully requested.

Rejection(s) under 35 U.S.C § 103

Claim 3

Claim 3 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Boivin in view of U.S. Patent Application Publication No. 2005075137 ("Reemtsma"). Claim 3 depends directly from independent claim 1. To the extent that this rejection applies to independent claim 1, the rejection is respectfully traversed.

"To establish a *prima facie* case of obviousness "...the prior art reference (or references when combined) must teach or suggest all the claim limitations." (*See* MPEP §2143.03). The

Applicants respectfully assert that the cited references, whether considered separately or in combination, fail to teach or suggest all the limitations of independent claim 1.

As discussed previously, Boivin does not teach or suggest all the limitations of independent claim 1. Further, Reemtsma does not teach that which Boivin lacks. This is evidenced by the fact that Reemtsma is only relied upon to teach "a first sending step where the application server sends a secure message for deleting the first identification data." *See* Office Action mailed May 3, 2007, p. 5. Moreover, Reemtsma is silent with respect to a first sending step and an inserting step. Specifically, Reemtsma teaches a method for simplifying the exchange of a SIM card of subscribers for a digital mobile communications network. *See e.g.*, Reemtsma, par. [0030]-[0031]. Accordingly, independent claim 1 is patentable over Boivin and Reemtsma. Dependent claim 3 is patentable for at least the same reasons. Thus, withdrawal of this rejection is respectfully requested.

Claims 4 and 6

Claims 4 and 6 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Boivin in view of Reemtsma and further in view of International Application Publication No. WO 98/56201 ("Oy"). Claims 4 and 6 depend, directly or indirectly, from independent claim 1. To the extent that this rejection applies to independent claim 1, the rejection is respectfully traversed.

As discussed previously, Boivin and Reemtsma, whether considered separately or in combination, fail to teach or suggest all the limitations of independent claim 1 and dependent claim 3. Further, Oy does not teach that which Boivin and Reemtsma lack. This is evidenced by the fact that Oy is only relied upon to teach "a method wherein the secure message is encrypted." *See* Office

Action mailed May 3, 2007, p. 6. Oy is silent with respect to a first sending step and an inserting step. Specifically, Oy is only directed to a method for controlling a SIM card in a mobile telephone network. *See e.g.*, Oy, p. 1, ll. 25-35. Accordingly, independent claim 1 is patentable over Boivin, Reemtsma, and Oy. Dependent claims 4 and 6 are patentable for at least the same reasons. Thus, withdrawal of this rejection is respectfully requested.

New Claims


New claims 11-12 depend directly from independent claim 1. New claims 13-14 depend directly from independent claim 8. Accordingly, dependent claims 11-14 are patentable over the cited references for at least the same reasons as independent claims 1 and 8. Further, none of the cited references disclose, teach, or suggest a communication device coupled to the first portable object during the first sending step, and removal of the first portable object to insert the second portable object, such that, the second portable object is coupled to the communication device during the second sending step. Thus, favorable action in the form of a Notice of Allowability is respectfully requested. *See* the new claims.

Conclusion

Applicants believe this reply is fully responsive to all outstanding issues and places this application in condition for allowance. If this belief is incorrect, or other issues arise, the Examiner is encouraged to contact the undersigned or his associates at the telephone number listed below. Please apply any charges not covered, or any credits, to Deposit Account 50-0591 (Reference Number 09669/064001).

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Respectfully submitted,

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